

REMARKS

Claims 1-5, 7-12, 15-19, 22-31, and 33-45 are pending in the application. Claims 15, 22, 44, and 45 are rejected under 35 U.S.C. § 102(b) and claims 1-5, 7-12, 16-19, 23-29, 30-31, and 33-43 are rejected under 35 U.S.C. § 103(a). Claims 15, 24, and 41-44 are amended herein to change the word “comprising” to the term “consisting essentially of.” Support for the amendments is found throughout the specification, and no new matter is added by these amendments. This amendment is timely filed in response to the Final Office Action mailed on September 7, 2007.

Telephonic Interview and Request to Withdraw Finality of Office Action

Applicant’s representative thanks Examiner Henry and Supervisory Examiner Meyer for extending the courtesy of an interview on December 7, 2007. At that telephone interview agreement was reached, as discussed below, that amendment of claims 15, 24, and 41-44 to replace the transitional word “comprising” with the term “consisting essentially of” would overcome the rejection of the claims under 35 U.S.C. §§ 102(b) and 103(a) over Bell. Agreement was reached, as discussed below, that the rejections under 35 U.S.C. § 103(a) of claims 1-5, 7-12, 23, 25-29, 31, and 34-40 over Paradisis in view of either Kostic or Boros were improper and thus would be withdrawn.

In the telephonic interview agreement was also reached that the finality of the September 7, 2007 Office Action would be withdrawn in view of the impropriety of the rejections under 35 U.S.C. § 103(a) over Paradisis in view of either Kostic or Boros. Thus, Applicant respectfully requests that the finality of the Office Action be withdrawn.

Special Status of Application

This application has special status. Applicant requested special status in a petition filed September 11, 2003. A status inquiry was filed January 19, 2007. The petition was granted January 24, 2007. In view of the late granting of this petition and the delays encountered in the prosecution of this application, Applicant requests expedited review of this response.

Rejection Under 35 U.S.C. § 102(b) over Bell

Claims 15, 22, 44, and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bell et al. (WO 99/65337). The Office Action states that Bell teaches Applicant's claimed method because the "comprising" language of Applicant's pending claims does not exclude the use or administration of additional ingredients or components to treat the osteoporosis or other conditions recited by the claims. Applicant notes that all of Bell's compositions comprise fiber and phytoestrogen (which are absent from Applicant's claims) and respectfully disagree with the assertion that Bell teaches Applicant's claimed methods. However, to hasten allowance of the claims, and as agreed in the telephonic interview on December 7, 2007, Applicant has amended the claims herein to change the word "comprising" to the term "consisting essentially of." Thus, the rejection under 35 U.S.C. § 102(b) is now moot and Applicant respectfully requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103(a) over Bell

Claims 16-19, 24, 30, 33, and 41-43 are rejected under 35 U.S.C. § 103(a) as being obvious over Bell et al. (WO 99/65337). The basis for the rejection is analogous to the rejection under 35 U.S.C. § 102(b) over Bell. That is, the Office Action states that Bell teaches Applicant's claimed method because the "comprising" language of the pending claims does not exclude the use or administration of additional ingredients or components to treat the osteoporosis or other conditions recited by the claims.

As discussed in the previous section, Applicant does not agree that Bell teaches or suggests Applicant's claimed methods. However, to hasten allowance of this application to issuance, Applicant's claims have been amended to replace the word "comprising" with the term "consisting essentially of." All of Bell's compositions comprise fiber and phytoestrogen, which are absent from Applicant's claims, and Bell would not motivate one of ordinary skill in the art to remove fiber and phytoestrogen from Bell's compositions. Thus, Applicant's claims are allowable over Bell and Applicant requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Rejection Under 35 U.S.C. § 103(a) over Paradissis in view of Kostic

The Office Action has maintained the rejection under 35 U.S.C. § 103(a) of claims 1-5, 7-12, 23, 25-29, 31, and 34-40 as being unpatentable over Paradissis et al. (U.S. Pat. No. 5,494,678) in view of Kostic (Archiv fuer Gynaekologie, 202: 506, 1965). Applicant traverses the rejection for the reasons of record in the previous Amendment filed April 9, 2007. In the telephonic interview on December 7, 2007, it was agreed that the combination of Paradissis and Kostic is improper because one of ordinary skill in the art would not be motivated to combine these two references, given that they address different, nonparallel areas of technology. Thus, agreement was reached in the telephonic interview that the rejection of the claims over Paradissis in view of Kostic would be withdrawn.

Rejection Under 35 U.S.C. § 103(a) over Paradissis in view of Boros

The Office Action has also maintained the rejection under 35 U.S.C. § 103(a) of claims 1-5, 7-12, 23, 25-29, 31, and 34-40 as being unpatentable over Paradissis et al. (U.S. Pat. No. 5,494,678) in view of Boros et al. (Proc. Am. Assoc. Cancer Res. Ann Meeting 41:666, March 2000) or Boros (Anticancer Res. 20:2245, 2000). Applicant traverses the rejection for the reasons of record in the previous Amendment filed April 9, 2007. In the telephonic interview on December 7, 2007, it was agreed that the combination of Paradissis with either of the Boros references is improper because one of ordinary skill in the art would not be motivated to combine these references, given that they address different, nonparallel areas of technology. Thus, agreement was reached in the telephonic interview that the rejection of the claims over Paradissis in view of either of the Boros references would be withdrawn.

CONCLUSION

Applicant submits that the pending claims define novel and patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims. No additional fees are believed due. However, the Commissioner is hereby authorized to charge any deficiencies that may be required or credit any overpayment to Deposit Account Number 11-0855.

Early and favorable consideration is earnestly solicited. If the Examiner believes any informalities remain in the application that can be resolved by telephone interview, a telephone call to the undersigned attorney is earnestly solicited.

Respectfully submitted,

/john mcdonald/

John K. McDonald, Ph.D.
Reg. No. 42,860

KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530
Telephone: 404-815-6500, direct 404-745-2470
Facsimile: 404-815-6555
Attorney Docket No. 52761-0110 (286146)